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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/677,551 | 10/02/2003 | Michael Robert Barbachyn | 01337.US1 | 9537 |

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PHARMACIA & UPJOHN
301 HENRIETTA ST
0228-32-LAW
KALAMAZOO, MI 49007

EXAMINER

HABTE, KAHSAY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,551

Applicant(s)

BARBACHYN ET AL.

Examiner

Kahsay Habte, Ph. D.

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1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-29 is/are rejected.
- 7) ☒ Claim(s) 17, 18 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are pending.

Response to Amendment

2. Applicant's amendment filed 1/27/2005 in response to the previous Office Action (10/28/2005) is acknowledged. Rejections of claims 1-16 and 19-29 under 35 U.S.C. § 112, first and second paragraph (paragraphs 6 and 7b-7f) have been obviated. The second paragraph rejection in items 7a has been maintained.
3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

Note that applicants indicate in the "REMARKS" that they have amended the claims to remove the non-elected subject matter, but the claims are still drawn to non-elected inventions. Note that Group I is drawn to [1,4]oxazino compounds (i.e. variable X in formula I is -C-O-C-). The variable X in claim 1 (page 8) is defined as $-(C(R^{15})_2)_m-O-(C(R^{15})_2)_k-$, thus, variables k and m should be both 1 to give [1,4]oxazino and not 0-2. It is required that applicants amend the claims so that variable k = 1 and m = 1.

Objection

4. Claims 17-18 and 30 are objected to as being drawn to multiple invention, but would be allowable if the non-elected invention are removed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 19-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 or elsewhere in the claims, the phrase "Each R³ is independently(d) C₁₋₇ alkyl which is optionally partially unsaturated" is incorrect. An "alkyl" or "cycloalkyl" group is already a saturated group and cannot be partially saturated. Like wise, the same rejection applies for "C₃₋₈ cycloalkyl" in claim 1 (line 29).

Response to arguments

Applicant's argument filed 1/27/2005 has been fully considered but it is not persuasive.

Applicants argue "the phraseology in claim 1, where an alternative to a recited group can be 'optionally partially unsaturated' is well understood by skilled artisan to mean that such groups need not be fully saturated and can contain, for example, a double or triple bond". The examiner disagrees with applicants. One skilled in the art

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would understand an "alkyl" or "cycloalkyl" groups as a saturated group. The use of alkyl or cycloalkyl in place of partially saturated or fully saturated alkyl violates the dictionary. It is suggested that applicants use "alkenyl" or "cycloalkenyl" for partially saturated alkyl or cycloalkyl; "alkynyl" for an alkyl with a triple bond. This would resolve the matter. Note that "alkene" or "cycloalkene" are the standard chemical terms given to describe a partially saturated alkyl or cycloalkyl. Like wise, "alkyne" is the standard chemical term for alkyl that contains a triple bond.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674, if there is no reply within 24 hours, James Wilson (Acting SPE) can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 7571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
Art Unit 1624

KH
February 15, 2005